OIPE
NOV 12 2003
PATENT & TRADEMARK OFFICE

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the U.S. Patent Application of
Wayne ANDERSON et al.

Examiner: James G. SMITH (expected)

Serial No.:10/673,604
Filed :September 29, 2003

Art Unit: 3723 (expected)
Docket No.: P-28 CIP2

Title: MULTIPLE-IN-1 PRECISION HAND TOOL

**CERTIFICATE OF EXPRESS MAILING**

I hereby certify that this correspondence is being deposited with the United States Postal Service as Express Mail in an envelope addressed to: Hon. Commissioner of Patents and Trademarks, Alexandria, VA 22313-1450 on:

Date
By :Marvin Feldman, Esq.
Mailing Label No .:EV 157098574 US
Signature :

Mail Stop - PETITION
Director of Patents
U.S. Patent Office
P.O. Box 1450, Alexandria, VA 22313-1450

PETITION TO MAKE SPECIAL UNDER 37 CFR §1.102 and MPEP §708.02 (VIII)

Applicant hereby petitions to make this application special.

1. **Accompanying Material**

    1. Presentation of Claims directed to single invention - earlier submitted within original application.
    2. Statement that a Preexamination Search was conducted, noting the field of search by class, subclass etc.
    3. One copy of each of the references deemed most closely related to the subject matter encompassed by the claims. A complete Information Disclosure Statement and PTO-1449 form is additionally included.
    4. Detailed Discussion of the references, noting that the claimed subject matter is patentable over the references for the additional limitations in the claims.

2. **Fee** (37 CFR §1.17(h)) - Attached is a check in the amount of $130.00.

3. A duplicate of this paper is provided.

11/17/2003 CCHAU1 00000028 10673604
01 FC:1460 130.00 OP

## REMARKS

Kindly note the materials provided. A clean copy of all filing papers, including the references is provided for your convenience.

Applicants thank Examiner Smith (expected) for his assistance in this matter.

In the spirit of condensed and streamlined practice, if Examiner James G. Smith (expected) believes that a telephone conference would be of value, he is respectfully requested to call the undersigned counsel at the number listed, for prompt response.

Early and favorable action is respectfully solicited.

*Applicant hereby requests and petitions that any and all extensions of time of the term necessary to render this response timely be granted and/or that all costs and fees required for the requested action herein, not otherwise provided herein, be charged to or credit returned to our* **Deposit Account No. 10-0100**

Dated: November 12, 2003

Respectfully submitted,

Lackenbach Siegel, LLP
One Chase Road
Scarsdale, NY 10583
Telephone: 914 723 4300
MF/ay

LACKENBACH SIEGEL, LLP
Attorneys for Applicant(s)

By: _____
Marvin Feldman
Reg. No.: 25,797

Enclosure(s):
As noted above

O:\1 Documents\2003\Bestway Tools\afy\P-28CIP2.Petition to make special.wpd

NOV 12 2003
TRADEMARK OFFICE

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the U.S. Patent Application of

**Wayne ANDERSON et al** Examiner: James G. SMITH (expected)

Serial No.: 10/673,604 Art Unit: 3723 (expected)

Date Filed: September 29, 2003 Docket No.:P-28CIP2

For: MULTIPLE-IN-1 PRECISION HAND TOOL

Mail Stop - PETITION
Director of Patents, U.S. Patent Office
P.O. Box 1450, Alexandria, VA 22313-1450

**ATTORNEY STATEMENT and DETAILED DISCUSSION in Support of our PETITION TO MAKE SPECIAL under MPEP §708.02**

SIR:

I make the following statements in Support of our Petition to Make Special under MPEP §708.02(VIII) (C).

(A) That I am one of the practitioner's in this case and am listed on the signed Declaration and Power of Attorney in this matter.

(B) That I have caused to be made a search of the pertinent prior art in the relevant classes and sub-classes as noted fully in the accompanying Information Disclosure Statement under (MPEP §609) and form PTO-1449 filed in this application herewith, along with a complete copy of each of the references noted.

(C) The listing of relevant class and subclass is provided herein in the accompanying PTO-1449 listing all remaining classes and all the references enclosed in the present submission.

Class 81 Tools
- 177 Handle
- 177.2 Extensible handle or handle extension
- 177.4 Having means for storing parts
- 438 Having structure adapting portion or tool for separation
- 439 Having structure adapting portion or tool for separation
- 451 Having structure adapting portion or tool for separation
- 471 Permanently deformable component
- 490 Having storage compartment

Class 7 Compound Tools
- 125 Plier Type
- 127 With tool or plier handle
- 128 with tool pivoted to plier

Class 30 Cutlery
- 125 Having structure adapting portion or tool for separation
- 161 Having structure adapting portion or tool for separation

(D) A Detailed Discussion of the references, pointing out with particularity how the noted claimed subject matter is patentable over the references. While MPEP §708.02(II) does not appear to require providing a comparison claim chart it is believed that this is, at present, the best way to provide the information requested.

| **Claim** | **Notes** |
|---|---|
| 1. A multiple-in-1 hand tool comprising;<br>tool bit members, each member having a body and oppositely disposed ends and having a tool bit disposed at each said end;<br>a tool bit driver in combination with a tool handle;<br>said driver comprising a handle having a proximate end and a distal end, and having elongated compartments to receive said tool bit members for storage within the compartments; and<br>said driver handle further comprising a handle cap, said driver handle cap comprising means for removably and rotatably attaching the cap to the handle proximate end to cover the compartments with the tool bit members in a closed position, said handle cap being rotatable in a closed position. | Alone or in combination, none of the references disclose a tool handle in combination with a tool bit driver, the driver handle having a handle cap removable and rotatably attaching and covering the compartment in a closed position. |

| | |
|---|---|
| 2. A multiple-in-1 hand tool comprising:<br>a handle in combination with a tool handle;<br>said handle having a proximate end and a distal end, and being formed with a plurality of compartments adjacent a proximate end for storing tool bits; and<br>a handle cap, said handle cap having a distal end and means for removably and rotatably attaching a handle cap distal end to said handle proximate end to cover said compartments containing the tool bits in a handle cap closed position, said handle cap being rotatable in the closed position. | None of the references, alone or in combination include a handle in combination with a tool handle, the handle having a plurality of compartments and a handle cap being removably and rotatably attached to the distal end of the handle and covering the compartments. |
| 3. The precision tool of claim 2, wherein:<br>the handle cap distal end is contoured for receiving the end of an index finger for precision tool bit drive use. | None of the references include the prior limitations with the additional finger contour on the handle cap. |
| 4. A precision multiple-in-1 hand tool comprising:<br>a handle in combination with a tool;<br>said handle having a proximate end and a distal end;<br>a handle cap removably and rotatably attached to the handle proximate end;<br>a shank having a proximate end disposed in the distal end of the handle and being extendable from the handle distal end,<br>a shank sleeve disposed at the distal end of the shank,<br>at least one tool bit member, one said tool bit member being operably disposable in said shank sleeve, said handle cap having means for restraining one tool bit member, and said handle being formed with elongated compartments for stowing a plurality of said tool bit members, each tool bit member comprising a body and oppositely disposed precision tool bits, wherein the length of each tool bit is about equal to the length of the member body; and<br>said handle cap covers the handle compartments with the stowed tool bit members in a closed position, and said handle cap being rotatable in the closed position. | None of the references, alone or in combination disclose a tool and a handle having a removably and rotatable cap with a shank holding a tool bit and means for removably and rotatably retaining a handle cap while restraining one tool bit member in use. |
| 5. The precision pocket tool of claim 4, wherein:<br>said handle cap being having a first contour to positionably receive the end of an index finger for precise tool use. | None of the references include the prior limitations nor include a first contour for a finger on the rotatable cap. |

| | |
|---|---|
| 6. A multiple-in-1 hand tool comprising:<br>at least one interchangeable tool bit member, opposed jaw tool members, first and second elongated handles having oppositely disposed first and second ends;<br>said jaw tool members being operably disposed at said first ends;<br>said first handle having opposed sides forming an elongated cavity;<br>a sleeve comprising a one-piece unitary construction formed with a body and having a closed-end and an open end, said open end being formed for removably and operably holding said tool bit member, said tool bit member being disposed in said sleeve;<br>means for pivotably fixedly connecting the sleeve adjacent the first handle second end so that the sleeve is non-removable, whereby the sleeve and the tool bit member are pivoted from a first position disposed away from the first handle to a second position disposed in the first handle cavity so that the sleeve and tool bit member are inoperably stowed in the first handle without having to remove and separately stow the tool bit member or sleeve outside the first handle cavity thereby permitting ready alternate pliers or selected tool bit use. | None of the references, alone or in combination include an alternative embodiment disclosing a tool bit member pivotably stored in a handle and removable in an open position for hand use separate from the jaw tool, where a sleeve stows and retains the tool bit members permitting alternative pliers or selected tool bit use. |
| 7. A multiple-in-1 hand tool, according to claim 6, wherein:<br>said tubular body having an outer surface, said sleeve closed-end having a flat end wall portion, said flat end wall portion extending to the tubular body outer surface. | In addition to the above limitations, none of the references have a flat wall section extending to a tubular body outer surface. |
| 8. A multiple-in-1 hand tool, according to claim 7, wherein:<br>said tool bit member comprising a double-ended tool bit, said double-ended tool bit being disposed between said first handle sides with said sleeve disposed in said inoperable position. | In addition to the above limitations, none of the references further describe a tool bit disposed between first handle sides with the sleeve in an inoperable position. |
| 9. A multiple-in-1 hand tool, according to claim 6, wherein said tubular body being formed with a wing member extending away from the outer surface of the tubular body. | None of the references include a wing member extending from the outer surface of the tubular body. |
| 10. A multiple-in-1 hand tool, according to claim 9, wherein:<br>said wing member extends axially from the flat end wall portion along said outer surface of said tubular body. | A wing member is lacking from each of the references, especially along the outer surface of the tubular body. |

| | |
|---|---|
| 11. A multiple-in-1 hand tool comprising:<br>at least one interchangeable tool bit member, opposed pliers jaws, first and second elongated handles having oppositely disposed first and second ends, said pliers jaws being operably disposed at said first ends;<br>said first handle having opposed sides forming an elongated cavity, a bladed tool, and means for pivotably connecting the bladed tool to the first handle adjacent the first handle second end;<br>a sleeve comprising a one-piece unitary construction formed with a substantially tubular body, and said tubular body having a closed-end and an open end, said open end being formed for removably storing said tool bit member, said tool bit member being disposed in said sleeve, means for pivotably fixedly connecting the sleeve adjacent the first handle second end so that the sleeve is non-removable, whereby the sleeve and the tool bit member are pivoted from a first position disposed away from the first handle to a second position disposed in the first handle cavity so that the sleeve and tool bit member are inoperably stowed in the first handle without having to remove and separately stow the tool bit member or sleeve outside the first handle cavity thereby permitting ready alternate pliers or tool bit use;<br>said tubular body having an outer surface, said sleeve closed-end having a flat end wall portion, said flat end wall portion extending to the tubular body outer surface; and<br>said tool bit member comprising a double-ended tool bit, said double-ended tool being disposed between said first handle sides with said sleeve disposed in said inoperable position. | None of the references, alone or combined include a sleeve for storing tool bit members, and means for pivotably connecting the sleeve to a handle, where a tubular body includes an outer surface for use during a removal of the tool bit member from the multiple-in-1 hand tool, enabling a user to operate a separate precision tool bit member. |
| 12. A multiple-in-1 hand tool, according to claim 11, wherein:<br>said tubular body being formed with a wing member extending away from the outside of the tubular body. | In addition to the above novel limitations, the body includes an extending wing member. |
| 13. A multiple-in-1 hand tool, according to claim 11, wherein:<br>said wing member extends axially along said outside of said tubular body. | None of the references disclose a wing member extending axially from the tubular body. |
| 14. A multiple-in-1 hand tool, comprising:<br>a tool bit member and a tool handle;<br>said tool handle having a sleeve comprising a one-piece unitary construction formed with a tubular body, and said tubular body having a closed-end and an open end, said open end being formed for removably storing said tool bit member, said tool bit member being disposed in said sleeve in a storage mode and removable for use during a use mode;<br>means for pivotably fixing said closed end of said tubular body to said tool handle whereby the sleeve and the tool bit member are pivoted from a first position disposed away from the first handle to a second position disposed in a first tool handle cavity so that the sleeve and tool bit member are inoperably storable in a first handle cavity without having to remove and separately store the tool bit member or sleeve outside the first handle, thereby permitting ready alternative tool bit member use apart from said tool handle. | None of the references, alone or in combination includes a means for pivotably fixing a closed end of the tubular body during a storage and enabling a storage of a tool bit member outside the first handle, permitting ready use of the tool bit member apart from the tool handle. |

| | |
|---|---|
| 15. A multiple-in-1 hand took, according to claim 14 wherein:<br>said tubular body being formed with a wing member extending axially along the outside of the tubular body. | In addition to the above limitations, a wing member on the tubular body extends axially. |
| 16. A multiple-in-1 hand tool, according to claim 14, wherein:<br>said tool bit member further comprises a body and an oppositely opened tool bit storage and holding cavity for receiving at least a tool bit during said use mode of said hand tool;<br>a plurality of storage cavities in said body opposite said storage and holding cavity for removably storing a plurality of tool bits; and<br>a top member on said tool bit member removably covering said plurality of storage cavities while providing a ready access. | None of the precision multiple-in-1 hand tools, alone or in combination include a body having storage cavities and a top member removably and pivotably covering the cavities in the hand tool. |
| 17. A multiple-in-1 hand tool, according to claim 16, further comprising<br>an intermediate sleeve slidably storable in said oppositely opened tool bit storage and holding cavity for receiving a precision tool bit during said use and enabling a retainment of said tool bit during staid storage mode. | None of the references include an intermediate sleeve slidably storable in the cavity and useable during both use and a storage mode. |
| 18. A multiple-in-1 hand tool, according to claim 14, wherein:<br>at least two tool bit members are disposed in said sleeve, whereby said two tool bit members enable a plurality of removable and useable tool bit members with a plurality of storage and holding cavities. | None of the references, in addition to the above limitations, includes a plurality of storage cavities in the sleeve. |
| 19. A multiple-in-1 hand tool, according to claim 11, wherein:<br>at least two tool bit members are disposed in said sleeve, whereby said two tool bit members enable a plurality of removable and useable tool bit members with a plurality of storage and holding cavities. | None of the references include each of the parent limitations for this claim and additionally allow a plurality of tool bits in use. |
| 20. A multiple-in-1 hand tool, according to claim 14, wherein:<br>at least two tool bit members are disposed in said sleeve, whereby said two tool bit members enable a plurality of removable and useable tool bit members with a plurality of storage and holding cavities. | None of the previous references includes the parent limitations for this claim or additionally allow at least two tool bit members to be disposed in the sleeve. |
| 21. A tool kit, comprising:<br>a hand tool including multiple and interchangeable tool bits in at least a storage body;<br>at least one tool handle, said first handle having opposed sides forming an elongated cavity and a one piece unitary sleeve member pivotably joined relative to a first end of said tool handle and having a closed-end and an open end, said open end being formed for removably storing said hand tool; and<br>said hand tool being removably disposed in said sleeve, whereby the sleeve and the hand tool are pivoted from a first position disposed away from the first handle to a second position disposed in the first handle cavity so that the sleeve and hand tool are inoperably stowed in the first handle without having to remove and separately stow the tool bit member, handle, or sleeve outside the first handle cavity thereby permitting ready alternate use of said tool kit. | None of the references, alone or combined, include a hand tool being removably disposed in a sleeve pivotable from a closed to an open position. None of the references further include the limitations of a removable tool handle in the sleeve, enabling use of a precision tool kit in separable parts for a user's convenience. |

| | |
|---|---|
| 22. A tool handle assembly, comprising:<br>a hand tool including multiple and interchangeable tool bits in at least a storage position;<br>at least one tool handle;<br>said at least one tool handle comprising an elongated body portion capable of defining proximate and distal ends;<br>a one piece unitary sleeve member having a closed-end and an open end, said closed end being pivotally joined to said elongated body portion relative to said proximate end, said open end being formed for removably retaining and storing said tool bits;<br>said hand tool being removably disposed in said sleeve; and<br>said sleeve member and said tool bits being pivotable from a first position disposed away from said at least one tool handle to a second position disposed adjacent to said at least one tool handle so that said sleeve member and tool bits are inoperably stowed in said tool handle, without having to remove and separately stow said tool bits, or said sleeve away from said at least one tool handle, thereby permitting ready alternate use of said tool handle assembly. | None of the references, alone or when combined, include each of the limitations, namely a tool handle and a sleeve member pivotably joined to a body portion where the handle is removably disposed in the sleeve and pivotable from a first closed position to a second open position and the sleeve and tool handle enabling the stowage of multiple tool bits in a compact shape. |

(E) For the reasons noted above, the undersigned believes it is clear that claimed subject matter when compared with the search results and the references cited herein, alone or when combined, is neither anticipated nor rendered obvious over the art searched.

It is specifically noted, that as required by MPEP §708.02 (VIII), only those references presently considered "most closely related" to the subject matter have been considered for comment in the chart above. The additional references noted in the broader search are included with the Information Disclosure Statement and PTO-1449.

In the spirit of condensed and streamlined practice, if the Examiner believes that a telephone conference would be of value, he is respectfully requested to call the undersigned counsel at the number listed below for a prompt response to the issue raised.

Early and favorable action is respectfully solicited.

Dated:
March 13 2003

Respectfully submitted,

Lackenbach Siegel, LLP
One Chase Road
Scarsdale, NY 10583
Telephone: 914 723 4300
MF/ay

LACKENBACH SIEGEL, LLP
Attorneys for Applicant(s)

By: _____
Marvin Feldman
Reg. No.: 25,797

Enclosure(s):
As noted above

O:\1 Documents\2003\Bestway Tools\afy\P-28CIP2.Atty Statement of search.wpd